REMARKS

INTRODUCTION:

In accordance with the foregoing, claims 1, 12, 25 and 26 have been amended. No new matter is being presented, and approval and entry are respectfully requested.

Claims 1-27 are pending and under consideration. Reconsideration is respectfully requested.

AMENDMENT OF CLAIMS 1 AND 12:

Claims 1 and 12 were amended to correct antecedent basis.

REJECTION UNDER 35 U.S.C. §112:

In the Office Action, at page 2, claims 25 and 26 were rejected under 35 U.S.C. §112, second paragraph, for the reasons set forth therein. This rejection is traversed and reconsideration is requested.

Claim 25 has been amended to depend from claim 24.

Claim 26 has been amended to recite:

26. An information retrieving method for retrieving design/manufacturing information of a great variety of file formats registered in a plurality of web servers, by using an index server, the information retrieving method comprising:

a transmission step of transmitting an abstract and storage location information of design/manufacturing information registered in said web servers, to an index server during an idle time of said web servers; and

an automatic registration step of automatically registering an abstract and storage location information transmitted from web servers by said transmitting unit, into said index server,

wherein CAD design/manufacturing information, which includes at least one of ~~such as a~~ structure diagram of an ICAD-MX or a circuit diagram of the ICAD-MX is converted into text information, thereby to automatically generate an abstract.

Thus, claims 25 and 26 are now submitted to be definite under 35 U.S.C. §112, second paragraph.

REJECTION UNDER 35 U.S.C. §102:

A. In the Office Action, at pages 2-4, claims 1-3, 12-14 and 27 were rejected under 35 U.S.C. §102(e) as being anticipated by Yasue (USPN 6,289,345, hereinafter "Yasue"). This rejection is traversed and reconsideration is requested.

It is respectfully submitted that Yasue discloses a design information management system having a bulk data server and a metadata server. While the Examiner appears to regard the abstract and storage location information of the present invention as the management information of the model data of Yasue and to regard the index server of the present invention as the metaserver of Yasue. In Yasue, the management information is registered by the metaserver <u>during the implementing</u> updating of the model data. In contrast, in independent claims 1, 12 and 27 of the present invention the abstract and storage information of design/manufacturing information registered in the web server is transmitted to the index server <u>during the idle time</u> of the web server so that the information registered in the plurality of web servers may be automatically registered into the index server efficiently. Hence, the present invention, as claimed in independent claims 1, 12 and 27 is different from the invention of Yasue.

Thus, independent claims 1, 12 and 27 are submitted to be allowable under 35 U.S.C. §102(e) and not anticipated by Yasue (USPN 6,289,345). Since claims 2-3 and 11-14 depend from independent claims 1 and 12, respectively, claims 2-3 and 11-14 are submitted to be allowable under 35 U.S.C. §102(e) and not anticipated by Yasue (USPN 6,289,345) for at least the reasons that claims 1 and 12 are submitted to be allowable under 35 U.S.C. §102(e) and not anticipated by Yasue (USPN 6,289,345).

B. In the Office Action, at pages 5-9, claims 1-3, 5-14 and 16-22 were rejected under 35 U.S.C. §102(e) as being anticipated by Hazama et al. (USPN 6,539,399, hereinafter "Hazama"). This rejection is traversed and reconsideration is requested.

Hazama discloses a stand-alone data management system to facilitate sheet metal part production. In Hazama, the data files of the sheet metal parts are stored in the database 42,

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and the names and the locations of the various files related to each part are stored in the index 64. It appears that the Examiner seems to regard the index server of the present invention as the server 50 (or 60), which includes the index 64, of Hazama. However, in Hazama, regarding the timing of transmitting/registering the information to the server, there is only a description of "the system of the present invention is a distributed system that operates on any type of computer only when the data is being manipulated." Thus, it is respectfully submitted that the present invention as recited in independent claims 1 and 12 is different from the invention of Hazama with respect to the timing of registering the information.

Hence, it is submitted that independent claims 1 and 12 of the present invention are allowable under 35 U.S.C. §102(e) and not anticipated by Hazama et al. (USPN 6,539,399). Since claims 2-3, 5-11, 13-14 and 16-22 depend from claims 1 and 12, claims -3, 5-11, 13-14 and 16-22 are submitted to be allowable under 35 U.S.C. §102(e) and not anticipated by Hazama et al. (USPN 6,539,399) for at least the reasons that independent claims 1 and 12 are submitted to be allowable under 35 U.S.C. §102(e) and not anticipated by Hazama et al. (USPN 6,539,399).

REJECTION UNDER 35 U.S.C. §103:

A. In the Office Action, at pages 9-10, claims 4 and 15 were rejected under 35 U.S.C. §103(a) as being unpatentable over Yasue in view of Copperman et al. (USPN 6,711,585, hereinafter "Cooperman").The reasons for the rejection are set forth in the Office Action and therefore not repeated. The rejection is traversed and reconsideration is requested.

It is respectfully submitted that independent claim 1, and claim 12 in similar fashion, of the present invention recites an information retrieving system for retrieving design/manufacturing information of a great variety of file formats registered in a plurality of web servers, by using an index server, said information retrieving system comprising: a transmitting unit that transmits an abstract and storage location information of design/manufacturing information registered in said web servers, to an index server during an idle time of the web servers; and an automatic registering unit that automatically registers an abstract and storage location information transmitted from said web servers by said transmitting unit, into said index server, which is not taught or suggested by Yasue or Copperman. Thus, independent claims 1

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and 12 are submitted to be non-obvious with respect to 35 U.S.C. §103(a) and to be patentable over Yasue since, as noted by the Examiner, Yasue does not show converting the abstract data into an XML format. Since claims 4 and 15 depend from claims 1 and 12, respectively, claims 4 and 15 are submitted to be non-obvious with respect to 35 U.S.C. §103(a) and to be patentable over Yasue for at least the reasons that claims 1 and 12 are submitted to be non-obvious with respect to 35 U.S.C. §103(a) and to be patentable over Yasue.

In contrast to the information retrieving system (see claim 1 above and claim 12) taught by the present invention, Copperman teaches a method and system to organize and retrieve information using taxomomies, a document classifier and an autocontextualizer. In Copperman, there is no teaching or suggestion of an information retrieving system for retrieving design/manufacturing information of a great variety of file formats registered in a plurality of web servers, by using an index server, said information retrieving system comprising: a transmitting unit that transmits an abstract and storage location information of design/manufacturing information registered in said web servers, to an index server during an idle time of the web servers; and an automatic registering unit that automatically registers an abstract and storage location information transmitted from said web servers by said transmitting unit, into said index server, as is recited in claim 1, and similarly in claim 12, of the present invention. Thus, claims 1 and 12 of the present invention are submitted to be non-obvious with respect to 35 U.S.C. §103(a) and to be patentable over Copperman. Since claims 4 and 15 depend from claims 1 and 12, respectively, claims 4 and 15 are submitted to be non-obvious with respect to 35 U.S.C. §103(a) and to be patentable over Copperman for at least the reasons that claims 1 and 12 are submitted to be non-obvious with respect to 35 U.S.C. §103(a) and to be patentable over Copperman.

The genius of invention is often a combination of known elements which in hindsight seems preordained. To prevent hindsight invalidation of patent claims, the law requires some "teaching, suggestion or reason" to combine cited references. <u>Gambro Lundia AB v. Baxter Healthcare Corp.</u>, 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997). When the art in question is relatively simple, as is the case here, the opportunity to judge by hindsight is particularly tempting. Consequently, the tests of whether to combine references need to be applied rigorously. <u>See In re Dembiczak</u>, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999), <u>limited on other grounds by In re Gartside</u>, 203 F.3d 1305, 53 USPQ2d 1769 (2000) (guarding against falling victim to the insidious effect of a hindsight syndrome wherein that

which only the inventor taught is used against its teacher). Hence, it is respectfully submitted that it is inappropriate to use hindsight to combine Yasue with Copperman to use against the present invention.

It is respectfully submitted that the courts have held that the Examiner may not suggest modifying references using the present invention as a template absent a suggestion of the desirability of the modification in the prior art. *In re Fitch*, 23 U.S.P.Q.2d 1780, Fed Cir. 1992. Something in the prior art as a whole must suggest the desirability, and thus, the obviousness, of making the combination. *Alco Standard Corp. v. Tennessee Valley Authority*, 808 F. 2d 1490, 1 U.S.P.Q. 2d 1337 (Fed. Cir. 1986). When a rejection depends on a combination of prior art references, there must be some teaching, suggestion or motivation to combine the references. *In re Geiger*, 815 F.2d 686, 688 2 U.S.P.Q.2d 1276, 1278 (Fed. Cir. 1987). Thus, since there is no teaching or suggestion of combining Yasue with Copperman, it is respectfully submitted that claims 1 and 12, as well as claims 4 and 15, are non-obvious in view of Yasue,and further, in view of Copperman.

Since claims 4 and 15 are submitted to be non-obvious with respect to 35 U.S.C. §103(a) with respect to Yasue and Copperman individually, claims 4 and 15 are also submitted to be non-obvious with respect to 35 U.S.C. §103(a) with respect to Yasue and Copperman in combination.

B. In the Office Action, at pages 10-11, claim 23 was rejected under 35 U.S.C. §103(a) as being unpatentable over Yasue in view of Govindarajan et al. (USPN 6,208,659, hereinafter "Govindarajan").The reasons for the rejection are set forth in the Office Action and therefore not repeated. The rejection is traversed and reconsideration is requested.

The Examiner admits that Yasue does not show the information retrieving method is carrier out when registered information is dropped onto a registration icon prepared at the registration side. Although Govindarajan discloses a data processing system and method for providing personal information in a communication network and after a user uses a drag and drop of the document onto an inactive icon, the web card database/server determines whether the user desires to store the message to be forwarded at a later time than at step 1206, Govindararajan fails to teach or suggest an information retrieving method for retrieving design/manufacturing information of a great variety of file formats registered in a plurality of web servers, by using an index server, the information retrieving method comprising: a transmission step of transmitting an abstract and storage location information of design/manufacturing

information registered in said web servers, to an index server during an idle time of said web servers; and an automatic registration step of automatically registering an abstract and storage location information transmitted from web servers by said transmitting unit, into said index server, wherein the information retrieving method is automatically carried out when registered information is dropped onto a registration icon prepared at the registration side, as is recited by claim 23 of the present invention.

It is respectfully submitted that the courts have held that hindsight may not be used to pick and choose elements of a plurality of references using the present invention as a template to form a basis to reject the present invention as being obvious (see A above).

The courts have held that the Examiner may not suggest modifying references using the present invention as a template absent a suggestion of the desirability of the modification in the prior art. *In re Fitch*, 23 U.S.P.Q.2d 1780, Fed Cir. 1992. Something in the prior art as a whole must suggest the desirability, and thus, the obviousness, of making the combination. *Alco Standard Corp. v. Tennessee Valley Authority*, 808 F. 2d 1490, 1 U.S.P.Q. 2d 1337 (Fed. Cir. 1986). When a rejection depends on a combination of prior art references, there must be some teaching, suggestion or motivation to combine the references. *In re Geiger*, 815 F.2d 686, 688 2 U.S.P.Q.2d 1276, 1278 (Fed. Cir. 1987). Thus, since there is no teaching or suggestion of combining Yasue with Govindarajan, it is respectfully submitted that claim 23 is non-obvious over Yasue in view of Govindarajan.

Thus, it is respectfully submitted that claim 23 is non-obvious under 35 U.S.C. §103(a) and is patentable over Yasue and/or Govindarajan, alone or in combination.

C. In the Office Action, at pages 11-12, claim 24 was rejected under 35 U.S.C. §103(a) as being unpatentable over Yasue in view of Tanaka (USPN 5,732,264, hereinafter "Tanaka").The reasons for the rejection are set forth in the Office Action and therefore not repeated. The rejection is traversed and reconsideration is requested.

The Examiner admits that Yasue is silent as to how the system handles the data when there is no suitable drawing number given and that Yasue does not show generating a drawing number from a drawing number or an abstract in a higher-order system if no drawing number exists. Tanaka discloses an information management system and method for managing processing, storing and displaying attribute information of object information, and when object

information is a drawing, drawing numbers are assigned by hierarchical classification codes such as a section, a subsection, a class, a subclass, etc. on the basis of purposes or functions as attribute information. However, there is no teaching or suggestion of using Tanaka to modify the system of Yasue so as to generate a drawing number from a drawing number or an abstract in a higher-order system if no drawing number exists. It is respectfully submitted that the courts have held that hindsight may not be used to pick and choose elements of a plurality of references using the present invention as a template to form a basis to reject the present invention as being obvious (se A above).

The courts have held that the Examiner may not suggest modifying references using the present invention as a template absent a suggestion of the desirability of the modification in the prior art. *In re Fitch*, 23 U.S.P.Q.2d 1780, Fed Cir. 1992. Something in the prior art as a whole must suggest the desirability, and thus, the obviousness, of making the combination. *Alco Standard Corp. v. Tennessee Valley Authority*, 808 F. 2d 1490, 1 U.S.P.Q. 2d 1337 (Fed. Cir. 1986). When a rejection depends on a combination of prior art references, there must be some teaching, suggestion or motivation to combine the references. *In re Geiger*, 815 F.2d 686, 688 2 U.S.P.Q.2d 1276, 1278 (Fed. Cir. 1987). Thus, since there is no teaching or suggestion of combining Yasue with Tanaka, it is respectfully submitted that claim 24 is non-obvious in view of Yasue, and further, in view of Tanaka.

Thus, it is respectfully submitted that claim 24 is non-obvious under 35 U.S.C. §103(a) and is patentable over Yasue and/or Tanaka (USPN 5,732,264), alone or in combination.

CONCLUSION:

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot, and further, that all pending claims patentably distinguish over the prior art. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for allowance which action is earnestly solicited.

If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited by the Examiner contacting the undersigned attorney for a telephone interview to discuss resolution of such issues.

If there are any underpayments or overpayments of fees associated with the filing of this Amendment, please charge and/or credit the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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